No. 79-839

In the Supreme Court of the United States

OCTOBER TERM, 1979

IRONS AND SEARS, PETITIONER

v.

COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

WADE H. MCCREE, JR.
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Petitioner brought this action pursuant to the Freedom of Information Act, 5 U.S.C. (FOIA), to compel disclosure of all Patent and Trademark Office (PTO) decisions disposing of requests by would-be patentees for filing dates earlier than the one initially assigned their applications (Pet. App. 3a).[1]

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[1]The Patent and Trademark Office agreed to make available to petitioner all decisions denying earlier filing dates contained in patent files and, after deletion of confidential material, all such decisions in abandoned applications. However, it refused to release decisions granting earlier filing dates and decisions denying earlier filing dates that pertained to pending applications (Pet. App. 4a). The PTO also agreed to provide indices to the decisions to which it granted access (*ibid.*).

The district court granted the PTO's motion for summary judgment, holding that the requested decisions were exempt from disclosure pursuant to Exemption 3 of the FOIA, 5 U.S.C. 552(b)(3), read in conjunction with 35 U.S.C. 122—a provision of the patent statute requiring that patent applications and information concerning them ordinarily be kept in confidence (Pet. App. 21a-22a). The court of appeals affirmed in substantial part, noting that Exemption 3 excludes from FOIA coverage matters that are "specifically exempted from disclosure by statute * * *, provided that such statute * * * refers to particular types of matters to be withheld." Reasoning that 35 U.S.C. 122 affirmatively requires nondisclosure of particular sorts of material—patent applications and information concerning them—subject only to a discretionary but narrow "special circumstances" exception, the court of appeals found that the documents were exempt insofar as they related to pending or abandoned applications (Pet. App. 9a). The court noted, however, that the PTO also appeared to have denied access to decisions granting earlier filing dates on applications that had already issued as patents. Because the district court did not address that class of decisions, the court of appeals remanded with instructions to determine the proper disposition of those decisions (*id.* at 12a-15a).

Petitioner challenges the court of appeals' decision on two grounds, neither of which has merit or warrants review by this Court.

1. Petitioner contends (Pet. 15) that the FOIA overrides the confidentiality requirement of 35 U.S.C. 122 unless the government demonstrates that withholding the requested information would serve a particular governmental purpose. But 5 U.S.C. 552(b)(3) requires

no such showing. Because 35 U.S.C. 122 specifically provides that information concerning patent applications must be kept confidential, the court of appeals correctly held that the requested decisions—information concerning patent applications—are exempt from disclosure by statute. This decision is consistent with the decisions of the other courts of appeals that have addressed the question.[2]

2. Petitioner also contends (Pet. 13) that the court of appeals' determination that 35 U.S.C. 122 constitutes a "flat prohibition on disclosure" of information concerning patent applications conflicts with the court's earlier ruling in *Irons* v. *Gottschalk*, 548 F. 2d 992 (1976), that non-exempt material may be segregated and disclosed. *Irons* v. *Gottschalk* is inapposite. There, petitioner sought all unpublished Patent Office manuscript decisions. Those manuscript decisions contained information concerning existing patents (which may be disclosed) as well as information concerning pending and abandoned applications (which may not be disclosed). Recognizing that the case involved "integrated volumes of both exempt and non-exempt material," the court remanded with instructions to determine which portions of the manuscripts contained information that "can be excised in order that the non-exempt portions can be disclosed." 548 F. 2d at 996. Here, there is no non-exempt material at issue. Because 35 U.S.C. 122 specifically provides that "no information" concerning patent applications may be released, the court of appeals

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[2]See *Lee Pharmaceuticals* v. *Kreps*, 577 F. 2d 610 (9th Cir. 1978), cert. denied, 439 U.S. 1073 (1979), and *Sears* v. *Gottschalk*, 502 F. 2d 122 (4th Cir. 1974), cert. denied, 425 U.S. 904 (1976), where the courts held that 35 U.S.C. 122 is an "Exemption 3 statute" that exempts abandoned patent applications from disclosure.

correctly held that all of the requested information concerning pending and abandoned applications was exempt from disclosure. The court's decision is therefore consistent with its earlier opinion in *Irons*.[3]

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.
Solicitor General

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[3]In any event, an intra-circuit conflict is not an appropriate basis for granting a writ of certiorari. See *Wisniewski* v. *United States*, 353 U.S. 901, 902 (1957).